

REMARKS

Claims 13-23 remain in the application. Claims 14-16, 18-21 and 23 have been amended.

Restriction is required to the following groups of inventions:

Group 1, claims 13-16;

Group 2, claims 17-21; or

Group 3, claims 22-23.

The Applicants provisionally elect, with traverse, the inventions of Group 3, namely claims 22-23.

The Applicants respectfully traverse this restriction requirement for the following reasons. First, independent claims 17 and 22 are closely related. Each recites one or more print elements and a storage reservoir. However, while claim 17 recites "a temperature control means for **regulating** the temperature of the temperature control medium that flows from the reservoir to the print elements so as to regulate the temperature of the print head," claim 22 recites "a temperature controller coupled to the first and second temperature sensors and to the reservoir, the temperature controller being adapted to sense the temperatures measured by the first and second sensors and to regulating the temperature of the temperature control medium in the reservoir in response to the measured temperatures so as to **regulate** the temperature of the print head." The temperature controller of claim 22 is a more specific example of a temperature control means. Thus, claims 17-23 should be examined as a group.

Further, claim 13-16 are method claims that are analogous to the limitations of at least some of claims 17-23. Thus, the Applicants respectfully submit that there would not be any additional burden in examining these claims.

The restriction requirement is respectfully traversed because "if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct invention." Manual of Patent Examining Procedure (MPEP) § 803. Thus, even if the inventions are independent or distinct, restriction is improper **if the search and examination of all the claims can be made without serious burden.**

One of the "two criteria for a proper requirement for restriction between patentably distinct inventions" is that "[t]here must be a *serious* burden on the examiner if restriction is not required..." See *id.* (emphasis added). While "[f]or purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 803.02." See *id.*

The Office Action does not particularly articulate, however, an explanation of separate classification, or separate status in the art, or a different field of search." For at least these reasons, the Applicants respectfully submit that a *prima facie serious burden* has not been shown. Thus, the Applicants respectfully request reconsideration of the restriction requirements.

MPEP § 803.02 requires examination on the merits when there is not a serious burden imposed on the Examiner. The Applicants respectfully submit that the Examiner has not made a *prima facie* showing of a serious burden, as explained above.

The Applicants respectfully submit that the search and examination of all of the pending claims can be made without serious burden to the Examiner. Thus, the Applicants respectfully request that the present restriction requirement be reconsidered. At the very least claims 17-23 should be examined as a group.

Please charge any fees due in connection with this submission to Deposit Account No. 13-0017 in the name of McAndrews Held & Malloy, Ltd.

Respectfully submitted,

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